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FITZPATRICK CELLA
HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

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OFFICE OF PETITIONS

In re Application of :
Takeyama et al. :
Application No. 09/840,893 : DECISION ON APPLICATION
Filed: April 25, 2001 : FOR
Atty Docket No. 35.C13231 D2 : PATENT TERM ADJUSTMENT
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed June 9, 2005. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to eight hundred fifteen (815) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is eight hundred fifteen (815) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On April 20, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On June 9, 2005, applicants timely submitted an application for patent term adjustment (with required fee)¹. Applicants dispute the entry of a period of

¹ PALM records indicate that the Issue Fee payment was also received on June 9, 2005.

reduction of 515 days for applicants taking in excess of three months to respond to the non-final rejection mailed July 16, 2003. Applicants submit evidence to show that the holding of abandonment for failure to timely respond to the Office action was withdrawn based on their showing that a response had been timely filed on October 16, 2003. Furthermore, applicants assert entitlement to a period of adjustment of 429 days on the basis that the Office failed to respond within four months to the response filed October 16, 2003.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

A review of the application history reveals that no response to the Office action mailed July 16, 2003 was considered timely filed by the Office and the application became abandoned. Applicants were advised of the abandonment by notice mailed March 15, 2004. In response, on March 26, 2004 (and resubmitted on July 1, 2004), applicants filed a petition to withdraw the holding of abandonment. It is specifically noted that the petition to withdraw the holding of abandonment was filed within two months from the mailing date of a notice of abandonment. See § 1.704(c)(4). Moreover, by decision mailed March 14, 2005, the petition was granted on the basis that applicants had shown that a proper response was filed on October 16, 2003.

In view thereof, it is concluded that applicants did not fail to engage in reasonable efforts to conclude processing or examination of the application by delaying in replying to the Office action by 515 days. The response was filed within the three-month period under 37 CFR 1.704(b). Thus, no reduction was warranted.

Moreover, applicants are correct that given the showing of receipt of applicants' response in the Office on October 16, 2003, the application is entitled to a period of adjustment for Office delay. The Office did not take action in response until April 20, 2005. Pursuant to § 1.702(a)(2) and § 1.703(a)(2), the period of adjustment is 429 days, counting the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed, February 17, 2004 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, April 20, 2005.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is eight hundred fifteen (815) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Patent Publication so that a patent can be issued. The Issued Patent will include any period of adjustment accrued for Office failure to issue the patent within four months of the date of payment of the issue fee and satisfaction of all outstanding requirements.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Kery A. Fries
for

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen